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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,337	12/31/2003	Ga-Lanc Chen	US3712	8222
25859	7590	05/13/2008		
WEI TE CHUNG			EXAMINER	
FOXCONN INTERNATIONAL, INC.			MAPLES, JOHN S	
1650 MEMOREX DRIVE			ART UNIT	
SANTA CLARA, CA 95050			PAPER NUMBER	
			1795	
			MAIL DATE	
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			05/13/2008	
			PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/749,337

**Applicant(s)**

CHEN ET AL.

**Examiner**

John S. Maples

**Art Unit**

1795

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-8, 12-16 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. (New Rejection)

Applicant states details of the molecular layer that make up the separation membrane in paragraphs 7 and 12 of the present specification. These paragraphs state that the carbon atoms will attract lithium ions because of the dangling bonds of a carbon atom. This is incorrect and will not happen with the carbon atom because as applicant has pointed out in paragraph 12, each carbon atom is  $sp^2$  hybridized and forms a covalent bond with each neighboring carbon atom. Because of the covalent bonds between the carbon atoms there will not be any dangling bonds in the carbon atom and so the lithium ions will not be attracted to the carbon atoms.

It is also noted that applicant has stated in paragraph 12 that there are formed equilateral triangle units with a lithium ion 3 at each vertex with a carbon atom 2 located in a center thereof as seen in Figure 2 of the present specification. This configuration can also be viewed as the carbon atoms forming hexagons with the sides of each of the hexagons being the same length as each of the equilateral triangles. Applicant also states that the length of each side of the equilateral triangle is in the range of 25-100 nanometers. This is incorrect. Applicant stated that the carbon atoms are  $sp^2$  hybridized and thus the length between 2 carbons is only around 0.2 nanometers, which length is this well known bond length. Applicant's dimensions are thus off by a factor of at least one hundred.

Art Unit: 1795

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-8, 12-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. (New Rejection)

Applicant has not set forth in the present specification specifically how the claimed separation membrane is made or manufactured so that one of ordinary skill in this art could make and use the same. Applicant has not provided any examples or process steps that teach how the separation membrane is produced and so one of ordinary skill in this art would not be able to manufacture a separation membrane as applicant has set forth.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (New Rejection)

It is unclear what the expression "and or" in lines 3-4 of claim 14 means?

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of

each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-7, 12, 13, 15, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor-US 4,592,968 (Taylor) in view of Spotnitz et al.-US 6,322,923. (Spotnitz) (New Rejection)

The patent to Taylor teaches a separator comprising graphite used in electrochemical cells-see the abstract therein and column 1, lines 17-20. The separator comprises multiple layers of the claimed graphite structure and Taylor provides for a separator having a total thickness of around 1 mm-see column 7, lines 19-32. The only claimed feature not shown by Taylor is the lithium in the graphite forming the equilateral triangles. Spotnitz teaches a lithium electrochemical cell-see columns 1 and 2 of Spotnitz. To incorporate the lithium electrode of Spotnitz in the electrochemical cell using the separator of Taylor would have been obvious because Taylor provides for the utility in such cells. During discharging of the electrochemical cell of Taylor combined with Spotnitz, lithium would be found in the separator and would form the equilateral triangles with the carbon as applicant is claiming.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Maples whose telephone number is 571-272-1287. The examiner can normally be reached on Monday-Friday, 8:00-4:30.

Art Unit: 1795

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John S. Maples/

John S. Maples

Primary Examiner, Art Unit 1795

JSM/5-11-2008

